

REMARKS:

This application has been carefully studied and amended in view of the Office Action dated August 25, 2005. Reconsideration of that action is requested in view of the following.

The indication of allowability of claims 12, 16-17 and 19-20 is noted with appreciation. Of those claims claims 17 and 19 have been written in independent form. Claim 12 remains dependent on claim 4 and claim 16 remains dependent on claim 15. Claim 20 remains dependent on allowable claim 19.

It is respectfully submitted that parent claim 1 and its dependent claims are patentable over the prior art and particularly over Schaaf whether taken alone or in view of Watmough. Claim 1 has been amended to make clear the relationship between certain of the components of the assembly. In that regard, claim 1 previously recited the probe as "extending through said cylinder and mounted for joint back and forth movement with the cylinder". Claim 1 has now been amended to make clear that this joint movement is the result of the mounting of the probe with regard to the cylinder so that the back and forth movement of the probe is in response to the back and forth movement of the cylinder. Thus, both the probe and the cylinder move jointly. To make this feature absolutely clear claim 1 has now been amended to define the probe as "extending through said cylinder with said cylinder being between said clamp

mechanism and said probe and said probe being mounted for back and forth movement with said cylinder in response to the back and forth movement of said cylinder". It is submitted that this amendment to claim 1 does not introduce new elements and does not raise any new issues. Rather, it is simply an amplification or clarification of what had been previously defined. In that regard, claim 1 previously defined the cylinder as being clamped in the clamp mechanism and the probe as extending through the cylinder. Such arrangement would dispose the cylinder between the clamp mechanism and the probe. Claim 1, as previously noted, also defined the probe as being mounted for joint movement with the cylinder. Attached is a copy of page 760 of Webster's New World Dictionary, second college edition which contains the definition of "joint" and of "join". When used as an adjective "joint" means common to two or more actions. In addition, when "joint" is used as an adjective, reference is made to the definition of "join". "Join", in turn, means "1. to put or bring together; connect; fasten 2. to make into one; unite". Accordingly as previously defined in claim 1, the joint movement of the probe and cylinder meant a common or united movement. Thus, the amendment to claim 1 which replaces "joint" with "in response to the back and forth movement of said cylinder" is consistent with and does not introduce new issues as regards claim 1 before amendment.

In rejecting claim 1 and various dependent claims over Schaaf the Examiner took the position that the element 34 is the cylinder which is clamped in the clamp mechanism. What Schaaf specifically discloses is that the guide tube 34 and the surgical tool 35 are independently connected to the exit shaft 66 of the electric motor. Accordingly, Figure 6A uses two different directional arrows, namely, arrow X.1 to illustrate the movement of the guide tube 34 and the arrow X.2 for the movement of the surgical tool 35. Note also the specific and unequivocal statement at column 9, line 65 to column 10, line 4 that "The surgical tool 35...is in operative connection with the exit shaft 66 of the electric motor 65 via a coupling 75...The coupling 75 comprises a pressure piece 71 which is fastened...to the proximal end of the surgical tool 35 which is disposed within the guide tube 34." Thus, although the surgical tool 35 is "within" the guide tube 34, the mechanism for causing the reciprocal movement of the surgical tool is by means of attaching the end of the surgical tool to the motor shaft. Clearly, then the movement of the surgical tool (probe) in Schaaf is not one of "joint" movement with the guide tube (cylinder) but rather a movement which is independent of the guide tube. This clearly differs from claim 1 where the probe and cylinder are mounted for joint back and forth movement as previously defined or wherein the movement of the probe is "in response to the back and forth

movement of the cylinder" as now stated in claim 1.

The various claims which are dependent on claim 1, but which had been rejected should also be allowed by reason of their dependency on claim 1 and for the features defined in those claims. Note is made, for example, with regard to claim 5 which defined a plunger telescopically mounted in the cylinder for relative movement between the cylinder and the plunger. In rejecting claim 5 the Examiner referred to Schaaf as disclosing "a plunger telescopically mounted in the cylinder". It is not apparent, however, what structure the Examiner specifically has in mind when referring to the plunger. What is illustrated in Schaaf as being telescopically mounted in the cylinder is the surgical tool 35 within the guide tube 34. It is not apparent what other structure is being referred to as being within the guide tube 34. Figure 3A and Figure 6A, for example, show a further structural element 33 which is designated by Schaaf as being a channel, but the channel 34 is outside of or around the guide 34 and not telescopically mounted "in" the guide (cylinder).

Reconsideration is also requested of the reliance on Watmough with regard to the rejection of the various dependent claims defining the back and forth movement as being in a direction perpendicular to the longitudinal axis of the spindle. No issue is taken that such relative movement is disclosed in

Watmough. Issue is, however, taken with the obviousness of applying the Watmough disclosure to the Schaaf device. The actuator 70 which the Examiner construes as being a spindle is clearly longitudinally arranged in the same longitudinal direction as the guide tube 34 and surgical tool 35. A complete redesign of the Schaaf device would be necessary, without any motivation for such redesign, in order to make the direction of movement of the guide tube and surgical tool perpendicular to the longitudinal axis of the spindle. In order for the references to be properly combined there must be some motivation from the prior art to make that combination. Nothing in either Schaaf or Watmough gives any hint of the desirability or motivation for such combination. This is particularly so in view of the drastic redesign that would be necessary in Schaaf without any teaching as to how such could be done by Watmough.

For the reasons given above it is respectfully submitted that his application should be passed to issue. If the Examiner still maintains his rejection then it is respectfully requested that this amendment be entered for purposes of appeal.

Respectfully submitted,

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